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TOWNSEND and TOWNSEND and CREW LLP

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

JAMEY GRAHAM et al.

Application No.: 09/636,039

Filed: August 9, 2000

For: TECHNIQUES TO FACILITATE
READING OF A DOCUMENT

Customer No. 20350

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Examiner: Joshua D. Campbell

Technology Center/Art Unit: 2178

APPELLANTS' REPLY BRIEF UNDER
37 CFR §41.41

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This Reply Brief is submitted in response to the Examiner's Answer mailed September 16, 2009 (hereinafter "the Examiner's Answer"). The following remarks are intended to further focus the issues in the present appeal.

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1. STATUS OF CLAIMS

Claims 11-19, 30-38, and 40-44 are pending and are the subject of this appeal. Claims 11-19, 30-38, and 40-44 stand rejected pursuant to an Office Action mailed December 9, 2008.

Claims 11-19, 30-38, and 40-44 stand rejected under 35 U.S.C. §112, first paragraph because “the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with [the] claims.” (Office Action mailed December 9, 2008: pg. 2).

Claims 11-14, 17, 18, 30-33, 36, 37, and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adobe Acrobat Reader (published 1999, hereinafter “Acrobat Reader”) in view of U.S. Patent No. 5,546,502 to Hart et al. (hereinafter “Hart”), and further in view of U.S. Patent No. 6,326,957 to Nathan et al. (hereinafter “Nathan”).

Claims 15, 19, 34, 38, and 41-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Acrobat Reader in view of U.S. Patent No. 6,339,437 to Nielsen (hereinafter “Nielsen”), further in view of Hart, and further in view of Nathan.

Claims 16 and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Acrobat Reader in view of Nielsen, further in view of Hart, further in view of Nathan, and further in view of U.S. Patent Application Publication Number 2002/0065814 to Okamoto et al. (hereinafter “Okamoto”).

2. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 11-19, 30-38, and 40-44 are enabled.
2. Whether claims 11-14, 17, 18, 30-33, 36, 37, and 40 would have been obvious over Adobe Acrobat Reader, Hart, and Nathan.
3. Whether claims 15, 19, 34, 38, and 41-43 would have been obvious over Acrobat Reader, Nielsen, Hart, and Nathan.

4. Whether claims 16 and 35 would have been obvious over Acrobat Reader, Nielsen, Hart, Nathan, and Okamoto.

3. ARGUMENT

In the Examiner's Answer, the prior rejections were maintained and additional comments were presented in response to the Appeal Brief filed April 7, 2009 (the "Appeal Brief"). Appellants stand on the arguments presented in the Appeal Brief and present the following comments directed to the Examiner's Answer.

3.1 Claims 11-19, 30-38, and 40-44 are enabled

Appellants respectfully maintain that the feature "wherein each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords" as recited in claims 11-19, 30-38, and 40-44 is enabled under 35 U.S.C. §112, first paragraph.

As an initial matter, Appellants note that the enablement requirement of 35 U.S.C. §112, first paragraph does not require that a particular claim feature be described in the original disclosure. Rather, such a feature can be enabled if the claim language itself would be sufficient for one of ordinary skill in the art to make and use the feature. MPEP §2164 states:

The enablement requirement of 35 U.S.C. 112, first paragraph, is separate and distinct from the description requirement. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) ("the purpose of the 'written description' requirement is broader than to merely explain how to 'make and use'"). See also MPEP § 2161. Therefore, the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled. In other words, the statement of a new limitation in and of itself may enable one skilled in the art to make and use the claim containing that limitation even though that limitation may not be described in the original disclosure. Consequently, such limitations must be analyzed for both enablement and description using their separate and distinct criteria.

(MPEP §2164; emphasis added).

Since the Section 112, first paragraph rejection of claims 11-19, 30-38, and 40-44 is premised on the enablement requirement (rather than the written description requirement), Appellants submit that the question of whether the original disclosure adequately describes the claimed feature of “wherein each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords” is moot. Appellants submit that one of ordinary skill in the art would understand how to implement (i.e., make and use) this feature based solely on the language of the claims. Accordingly, Appellants submit that the Section 112, first paragraph rejection of 11-19, 30-38, and 40-44 with respect to enablement is improper, and respectfully request that the rejection be reversed.

Even if the Examiner intended to reject the claims under the written description requirement of Section 112, first paragraph, Appellants submit that the rejection is still improper. As explained in the Appeal Brief, specific support for the claimed feature “wherein each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords” can be found at, for instance, page 6, lines 18-25 of the Specification, which states “a marginal annotation in the form of rectangular bar may indicate a paragraph that has been determined to have relevance above a predetermined threshold or to have more than a threshold number of key phrases...” This section provides at least one example of visually emphasizing related text (e.g., a paragraph) that surrounds the locations of one or more keywords (e.g., key phrases in the paragraph).

The Examiner’s Answer argues that “merely placing a bar in the margin... does not support the limitation of visually emphasizing ‘related text’ surrounding the keywords” because “the margin can by no means be defined as being ‘related text’ and by placing a bar in the margin the actual ‘related text’ itself has not be visually emphasized in any way, visually the ‘related text’ has been completely unaffected.” (Examiner’s Answer: pg. 13). Appellants respectfully disagree.

The Examiner appears to be reading into the claims a limitation that the claimed “related text” must be visually emphasized by modifying some characteristic of the text itself. However, no such limitation exists. Rather, the claims broadly recite that the related text is visually emphasized. Appellants submit that such visual emphasis can be achieved in ways that

do not require modification of the related text itself, such as by creating a marginal annotation in the form of a rectangular bar that spans the vertical length of the text as described in Appellants' Specification. Accordingly, Appellants respectfully submit that claims 11-19, 30-38, and 40-44 satisfy the written description requirement of Section 112, first paragraph.

3.2 Claims 11-14, 17, 18, 30-33, 36, 37, and 40 would not have been obvious over Acrobat Reader, Hart, and Nathan

Appellants respectfully maintain that claims 11-14, 17, 18, 30-33, 36, 37, and 40 would not have been obvious over Acrobat Reader, Hart, and Nathan, considered individually or in combination, for at least the following reasons.

3.2.1 Acrobat Reader, Hart, and Nathan fail to teach or suggest displaying annotations that visually emphasize related text surrounding the locations of keywords

Acrobat Reader, Hart, and Nathan fail to teach or suggest "displaying annotations that visually emphasize portions of the document... wherein each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords" as recited in claims 11-14, 17, 18, 30-33, 36, 37, and 40. The Examiner's Answer asserts that this feature is shown in Hart because "Hart teaches a system that searches for a concept (one or more keyword) and in the process of searching for the concept it emphasizes both the concept and other text patterns (related text) related to the concept that are also throughout (surrounding the keywords) the document containing the concept (column 3, line 39-column 4, line 61 of Hart)." (Examiner's Answer: pg. 15). Appellants respectfully disagree.

The cited section of Hart describes an information retrieval system configured to store technical documents about an apparatus (e.g., a photocopier). A user can enter into the system symptoms that are observed with respect to the apparatus. The system can identify faults (i.e., causes) associated with the symptoms. The system can then provide to the user documents that are relevant to the symptoms and/or faults. (Hart: col. 4, lines 13-61).

Thus, at best, the cited section of Hart merely discloses the concept of retrieving documents in response to search criteria (i.e., symptoms or faults). The cited section makes

absolutely no reference to displaying annotations that visually emphasize portions of a single document, let alone annotations that visually emphasize both keywords and related text surrounding the keywords in the document. Appellants note that FIG. 11 of Hart illustrates a user interface used by the system of Hart to display retrieved documents to a user. As can be seen, the document shown in FIG. 11 is not displayed with any annotations, let alone the specific annotations recited in Appellants' claims.

The deficiencies of Hart in this regard are not remedied by Acrobat Reader or Nathan. Accordingly, Acrobat Reader, Hart, and Nathan fail to teach or suggest "displaying annotations that visually emphasize portions of the document... wherein each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords" as recited in claims 11-14, 17, 18, 30-33, 36, 37, and 40.

3.2.2 Acrobat Reader, Hart, and Nathan fail to teach or suggest dynamically changing the contents of a thumbnail image to reflect a change in contents of a document displayed in a first viewing area

Acrobat Reader, Hart, and Nathan fail to teach or suggest "dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document displayed in the first viewing area" as recited in claims 11-14, 17, 18, 30-33, 36, 37, and 40. The Examiner's Answer asserts that this feature is shown by a combination of Acrobat Reader and Nathan because "Acrobat teaches that a document viewing area would contain a document in one viewing area and a thumbnail representation of the document in a second viewing area" and "Nathan teaches that a thumbnail image representing a document should be dynamically updated." (Examiner's Answer: pg. 14). However, Appellants submit that there is no rationale for combining Acrobat Reader and Nathan in the manner suggested by the Examiner.

The Acrobat Reader reference provided by the Examiner comprises, in its entirety, five screenshots. Each screenshot includes a first viewing area in which a portion of a document is depicted in an un-editable (i.e., read-only) window, and a second viewing area in which the document is depicted as a series of thumbnail images. Thus, as best understood from these screenshots, the Acrobat Reader application is merely a viewer application; in other words,

a user can display and navigate through a document using the first and second viewing areas, but the user cannot dynamically change the content of the document in the first (or second) viewing area.

Since a document cannot be dynamically modified in the Acrobat Reader reference, Appellants submit that there would be no reason to combine Acrobat Reader and Nathan to arrive at the feature of “dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document displayed in the first viewing area” as recited in Appellants’ claims. As explained in the Appeal Brief, Nathan describes a personal digital notepad (PDN) device that includes a digitizing tablet portion for capturing the strokes of a user’s handwriting. While the strokes entered by the user in the digitizing tablet portion can be shown as a thumbnail image in an LCD panel of the PDN device, Nathan does not provide a means for displaying the contents of the handwritten document in a “first viewing area” as recited in claims 11-14, 17, 18, 30-33, 36, 37, and 40. (Appeal Brief: pgs. 11-12).

The Examiner’s Answer apparently concedes that Nathan does not teach the claimed “first viewing area,” but asserts that Acrobat Reader can be combined with Nathan to cure this deficiency. Appellants respectfully disagree. As discussed above, the “first viewing area” in Acrobat Reader is an un-editable (i.e., read-only) window that does not allow for any modification of the document shown in the window. Accordingly, there would be no rationale for combining Acrobat Reader with Nathan (or any other reference) to dynamically change the contents of a thumbnail image in the second viewing area to reflect a change in the content of the document displayed in the first viewing area, because Acrobat Reader explicitly disallows any dynamic modification of the document at all.

The deficiencies of Acrobat Reader and Nathan in this regard are not remedied by Hart. Accordingly, Acrobat Reader, Hart, and Nathan fail to teach or suggest “dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document displayed in the first viewing area” as recited in claims 11-14, 17, 18, 30-33, 36, 37, and 40.

3.2.3 The Acrobat Reader and Nathan references are not valid prior art

As discussed in the Office Action Response filed March 6, 2008, Appellants submit that all of the features of the independent claims are supported by parent application U.S. Patent App. No. 08/995,616, filed on December 22, 1997. Appellants consequently submit that the Acrobat Reader reference (published 1999) and the Nathan reference (filed January 29, 1999) are not valid prior art references since the parent application predates these references.

In the Final Office Action mailed July 8 2008, the Examiner indicated that he could not find support in the parent application for the following claim language recited in the independent claims: "dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document displayed in the first viewing area." Appellants respectfully disagree.

Appellants submit that the parent application provides support for dynamically updating annotations in a document. Annotations can be generated at the time a user selects a document for browsing. (Specification of 08/995,616: pg. 6, line 26-pg. 7, line 6). However, the generation of annotations is not merely limited to when the user selects a document for browsing. The annotations can depend upon the user's selection of concepts of interest and these selections can be updated as the user is browsing the document. (Specification of 08/995,616: pg. 7, lines 7-13). A series of concept checkboxes can be included in the user interface that allow the user to select which concepts are of interest to the user and to adjust the sensitivity to apply when identifying potentially relevant locations within the document. (Specification of 08/995,616: pg. 4, lines 18-22). For example, the user can select a word or phrase in the document as being relevant to a particular concept of interest even though the word or key phrase has not yet been defined to be a keyword or key phrase.

The user can also change the perceived level of relevance of an existing keyword or key phrase. The relationships between concepts and keywords can be modifiable during use of the annotation system. These modifications can be made through explicit user feedback, such as that described above, or can automatically be performed in the background. As a result of these modifications, probability values used for determining relevancy can be changed, new connections between sub-concepts and concepts can be introduced, or new keywords or key

phrases can be introduced. (Specification of 08/995,616: pg. 9, lines 5-24). The annotations within the document can be based upon the level of relevance to the user of various concepts present in the document. If the user changes the level of relevance of keywords or key phrases and the annotations were not regenerated in response to these changes, the annotations would likely no longer correspond to areas of the document that are of interest to user. Accordingly, Appellants respectfully submit that dynamically updating of annotations is supported by the parent application.

Appellants further submit that the parent application provides support for dynamically updating the annotations within the claimed thumbnail image. The thumbnail image provides a view of the basis document structure, including annotations. Annotations added to the document can be reflected in the thumbnail image, facilitating users to quickly identify relevant text anywhere within the document. (Specification of 08/995,616: pg. 13, lines 3-5). If the annotations are dynamically updated in the document as described above, the corresponding annotations displayed in the thumbnail image can also be updated. Otherwise, if the annotations in the document changed and the displayed annotations in the thumbnail image were not updated, the annotations displayed in the thumbnail image would no longer correspond to the annotations found within the document, and a user would not be able to rely upon the thumbnail image to find relevant text within the document.

Appellants note that “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement.” (MPEP §2163.02; emphasis added). Rather, “the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” (MPEP §2163.02; emphasis added). As explained above, the Specification of the parent application does convey, with reasonable clarity to one of ordinary skill in the art, that Appellants were in possession of the invention, including the feature of “dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document displayed in the first viewing area” at the time of filing of the parent application.

For at least these reasons, Appellants submit that each of the features recited in the independent claims is fully supported by the parent application. Accordingly, Appellants respectfully submit that Acrobat Reader and Nathan are not valid prior art references, and thus the rejection of claims 11-14, 17, 18, 30-33, 36, 37, and 40 should be reversed.

3.3 Claims 15, 19, 34, 38, and 41-43 would not have been obvious over Acrobat Reader, Nielsen, Hart, and Nathan

Appellants respectfully maintain that claims 15-19, 34, 38, and 41-43 would not have been obvious over Acrobat Reader, Nielsen, Hart, and Nathan, considered individually or in combination.

Independent claims 19, 38, and 41 recite features that are similar to independent claims 11, 30, and 40, which are not rendered obvious by Acrobat Reader, Hart, and Nathan as discussed above. Nielsen does not provide any teaching that would remedy the deficiencies of Acrobat Reader, Hart, and Nathan in this regard. For example, in the Appeal Brief, Appellants specifically argue that Nielsen fails to teach or suggest the claimed feature of “displaying annotations that visually emphasize portions of the document...wherein each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords.” (Appeal Brief: pgs. 13-14). This argument is not challenged (and thus is apparently conceded) in the Examiner’s Answer. (Examiner’s Answer: pgs. 14-15). Accordingly, Appellants submit that claims 19, 38, and 41 are allowable for at least a similar rationale as discussed for claims 11, 30, and 40, and respectfully request that the rejection of these claims be reversed.

Claims 15, 34, 42, and 43 depend (either directly or indirectly) from independent claims 11 and 30 respectively, and thus derive patentability therefrom.

3.4 Claims 16 and 35 would not have been obvious over Acrobat Reader, Nielsen, Hart, Nathan, and Okamoto

Appellants respectfully maintain that claims 16 and 35 would not have been obvious over Acrobat Reader, Nielsen, Hart, Nathan, and Okamoto, considered individually or in combination.

For example, Acrobat Reader, Nielsen, Hart, Nathan, and Okamoto fail to teach or suggest “modifying the style information for the first concept thereby changing the appearance of the document displayed in the first viewing area” as recited in claim 16. A similar feature is recited in claim 35. The Examiner’s Answer asserts that this feature is shown in Okamoto at paragraphs 270-276 because:

Okamoto discloses a method in which a concept tag number, which corresponds to one of a plurality of concepts, is directly associated with a specific style (page 12, paragraph 0270-0276 of Okamoto). When that style information is changed all tags corresponding to the tag number associated with that style information will reflect that change (page 12, paragraph 0270-0276 of Okamoto). Thus, Okamoto teaches that each concept is explicitly associated with a concept number, the concept number being associated with a specific style.

(Examiner’s Answer: pg. 15).

However, as best understood, the cited section of Okamoto merely describes the concept of defining “highlight tag numbers” and associating “highlight tags” (e.g., “”) with each tag number. The cited section makes no reference to a “concept tag number” or a “concept number” as asserted in the Examiner’s Answer. Further, nowhere does the cited section of Okamoto indicate that modification of a highlight tag specifically causes a document that has already been displayed to change in appearance.

The deficiencies of Okamoto in this regard are not remedied by Acrobat Reader, Nielsen, Hart, or Nathan. Accordingly, Acrobat Reader, Nielsen, Hart, Nathan, and Okamoto fail to teach or suggest “modifying the style information for the first concept thereby changing the appearance of the document displayed in the first viewing area” as recited in claims 16 and 35.

4. CONCLUSION

For at least the foregoing reasons, it is respectfully submitted that the rejections of the claims should be reversed.

Respectfully submitted,

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